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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,815	11/10/1999	Jeffrey P. Bezos	249768014US	8505

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/437,815

Applicant(s)

BEZOS ET AL.

Examiner

Jeffrey D. Carlson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 31-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 31-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/27/2002.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to methods for advertising auctions with bidding.
 - II. Claims 10-23, drawn to using transaction points to purchase ads.
 - III. Claims 24-30, drawn to selecting ads for user based on analysis of user's activity history.

The inventions are distinct, each from the other because of the following reasons:

- 
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as bidding for ad placements using monetary funds. See MPEP § 806.05(d).
 4. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as bidding and selecting ad placements responsive to ad schedules, rather than user's activity history. See MPEP § 806.05(d).
 5. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such

as bidding and selecting ad placements responsive to ad schedules, rather than user's activity history. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Maurice Pirio on 6/27/2002 a provisional election was made without traverse to prosecute the invention of I, claims 1-9. Affirmation of this election has been made by applicant in the preliminary amendment filed 6/27/2002 which cancels non-elected claims 10-30.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Declaration

9. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68. There is no date of execution for the first inventor.

Claim Objections

10. Claim 5 is objected to because of the following informalities:

① ■ Claim 5 line 2, --a-- should be inserted before "category" for clarity.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6, 40, 50, 56-64 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

① ■ Claims 6, 40, 50, 60 and 71, are incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps, as best understood, are: the score claimed requires an advertising plan specifying plural ad placements over a predefined time period and a calculation of likelihood of "all the requested advertising being placed" based on the number of unplaced ads and the remaining time.

② ■ Claims 6, 40, 50, 60 and 71, there is no antecedent basis for "all the requested advertising of the bid".

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Claim 56 is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s): there is no step specifying that the bid is actually selected.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

14. Claims 1-6, 45-50, 55-60, 65-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Roth et al (US6285987). Roth et al teaches advertisers who submit ads over a network for future advertising opportunities. The bids specify an amount to pay to show an ad to a viewer having particular characteristics and on a website that meets a set of criteria [abstract]. When a website with advertising to be shown is requested, an ad opportunity is created. The system then chooses the highest bid from all submitted bids that meet the criteria for the display opportunity (user characteristics and type of requesting site). The associated ad is then delivered and displayed to the user at the browser [col 5 lines 29-45].

Regarding claims 2, 46, 67, the selection of winning bid is performed after the ad request/opportunity.

Regarding claims 3, 4, 47, 48, 57, 58, 68, 69, user demographics and time/date are used to specify and target bids. The selecting among the qualifying bids is therefore based on such criteria [col 14 lines 9-37].

Regarding claims 5, 49, 59, 70, Roth et al teaches targeting the ads according to site keywords [col 14 lines 9-22] as well as page category/content [col 1 lines 50-53] and type of page [col 5 line 40].

Regarding claims 6, 50, 60, 71, Roth et al teaches a scoring method that tends to ensure that all of the requested advertising will be placed [col 8 lines 33-40]. Roth et al teaches an overall number of ads to be shown (exposure) as well [col 8 lines 3-5].

Regarding claim 45, the bids/bid agents/bid criteria are stored in an orderly fashion in the system so as to associate the bids with the advertiser and related ad; this represents inherent storage in a database of some type. Roth et al also teaches a log and billing function so that ad placements are noted and the advertisers billed [col 12 lines 39-40].

Regarding claim 56, the bids are sent to the ad server 16 for selection. Transmission of the winning ad to the client provides an indication that the ad has been allocated. Display of the ad to the user represents an indication to the user that the ad has been allocated. Further, when the advertiser is billed for ads, this is an indication of the ad selection/placement/allocation.

Regarding claim 65, selection of the highest bid tends to maximize revenue.

Regarding claim 66, the bids inherently represent the intentions/plan of the advertiser. They plan to display ads on the types of pages and for the types of users specified in the criteria.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7, 8, 31-35, 37-43, 51, 52, 61, 62, 72, 73 are rejected under 35

U.S.C. 103(a) as being unpatentable over Roth et al in view of Copple et al

(US6178408). Roth et al teaches bidding a "price or amount" [abstract], but does not teach the use of "points". Copple et al teaches methods for accumulating "points" for participating in and making purchases over the Internet, for example [col 4 lines 6-11].

These points can then be used to bid on auctions of value. It would have been obvious to one of ordinary skill at the time of the invention to have enabled the advertising bidders of Roth et al to bid with any type of currency or value such as reward points for making transactions. It would have been obvious to one of ordinary skill at the time of the invention to have awarded points for any type of commercial transaction including transactions related to online-auctions so as to encourage a wide range of user-compensated-activity.

Regarding claims 41-43, the bids inherently represent the intentions/strategy of the advertiser. They plan to display ads on the types of pages and for the types of users specified in the criteria. Roth et al teaches that the ads be targeted to web page category/"type of page" as well as user characteristics. Such targeting criteria is inherently based on a correlation of such information to the types of ads to be presented. The advertiser inherently is seeking ad placement for items where the content/category of the page is related to the item being advertised. Roth et al also teaches targeting ads to users who have accessed certain types or categories of information [col 4 lines 63-67]. The Viewer History Data (viewing history, purchases, click through, etc) also provides an element for targeting [col 8 lines 65-67].

17. Claims 9, 53, 63, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al and Copple et al in view of Goldhaber et al (US5794210). Copple et al does not teach receiving rewards/points for clicking through one web page to another. Goldhaber et al however teaches such an idea as "negative pricing of information". Users are rewarded for clicking form one web page to another [col 7 lines 47-55]. It would have been obvious to one of ordinary skill at the time of the invention to have rewarded users who perform these actions with points useable in a an online auction for ad placements.

18. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al and Copple et al in view of Bates et al (US6339438). Roth et al does not teach

targeting/selecting an ad if the item advertised competes with the content in the display space. Bates et al however, teaches to target or select a competitors product advertisement based on the contents of the browser window, such as when it displays competitive items [col 7 lines 59-65]. It would have been obvious to one of ordinary skill at the time of the invention to have targeted ad placement/selection according to a whether the ad space displayed a competitor's offerings, so that the ad can be tightly related and relevant to the displayed user-requested information.

19. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al and Copple et al in view of Tulske, Jr et al (US6249768). Copple et al does not teach receiving rewards/points for providing web page links for others to select. However, Tulske, Jr et al teaches compensation for a user to provide referring links to an entity who rewards such activity [col 8 lines 14-17]. It would have been obvious to one of ordinary skill at the time of the invention to have rewarded such link referral with the reward point and auction system of Copple et al/Roth et al so that users can earn more points for various activities.

20. Claims 54 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al and Copple et al in view of Eldering (US6324519). While Roth et al teaches varying the bid amounts based on number of impressions or based upon user history [col 2 lines 31-41], there is no teaching for varying according to the degree which the ad criteria matches the page content. Eldering also teaches selecting targeted ads

for websites based upon bidding auctions [col 12 lines 9-26]. Eldering also teaches providing a bid and target criteria. Column 10 lines 37-41 teach that the bid amount varies according to the degree of correlation between advertiser specified criteria and the opportunity characteristics. It would have been obvious to one of ordinary skill at the time of the invention to have employed variable bid amounts by advertisers of Roth et al based on the degree of correlation between the advertisers criteria of "type of page" / page category (content), so that advertisers who are willing to pay more for better opportunities can do so.

Conclusion


21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Davis et al (US6269361) teaches advertisers bidding for ad opportunities on search result listings.
- Hanson et al (US5974398) teaches bidding for display opportunities. Several ads are shown and the end-user selects the ad of his choice; the user then receives the bid amount as compensation.
- Bid.com ("Bid.com launches advertising on its Canadia site", 3/25/1999, PR Newswire, p2223) teaches putting ads on online auction sites. Also taught is auction category sponsorship.
- CyberGold ("CyberGold to launch membership drive for web ad service", 5/27/1997, PR Newswire) teaches awarding users for visiting auction sites.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc
September 20, 2002